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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,884	09/12/2003	Robert K. Rowe	020204-001410US	6953
20350	7590	04/27/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				LAVIN, CHRISTOPHER L
ART UNIT		PAPER NUMBER		
		2624		

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/660,884	ROWE ET AL.
	Examiner Christopher L. Lavin	Art Unit 2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 February 2006.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 24-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 24-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 01/17/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This action is in response to the amendment filed on 02/13/06.

### ***Claim Rejections - 35 USC § 112***

1. Claims 24 – 41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for subepidermal tissue, does not reasonably provide enablement for all types of tissue. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The invention would not work for epidermal skin or tissue too deep into the body, for example the liver.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 24 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,628,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the patent discloses a different scope (subepidermal tissue vs. tissue) than claim 1, the patent anticipates claim 1. The patent also discloses an intra-patient difference database while the claim simply calls for a difference database; again while the scopes may be different the patient anticipates the claimed invention. Finally, the patent calls for “positively verifying” which is in no way different from the “identifying” called for in the claim.

***Allowable Subject Matter***

4. All of the claims would be allowable if the 112 and double patenting issues were resolved.

5. The following is a statement of reasons for the indication of allowable subject matter: The art of record does not teach nor does it suggest the specific features called for in the claims, particularly using a database of difference values to identify an individual. Wunderman teaches that a database is used to identify individuals; however, the database used by Wunderman holds initial readings (potentially averaged together) for an individual and not difference values.

6. The following claim 24 is drafted by the examiner and considered to distinguish patentably over the art of record in this application as well as correcting for the 112 issue; however the double patenting problems will need to be addressed by the applicant separately, is presented to applicant for consideration:

A method for identifying an individual, the method comprising: applying an incident optical spectral distribution to subepidermal tissue of the individual; measuring a response optical spectral distribution emanating from the subepidermal tissue; deriving a difference optical spectral distribution by performing a mathematical operation on the response optical spectral distribution and a reference optical spectral distribution; and determining whether characteristics of the difference optical spectral distribution are consistent with the individual being a person associated with the reference optical spectral distribution, wherein determining whether characteristics of the difference optical spectral distribution are consistent with the individual being a person associated with the reference optical spectral distribution comprises analyzing the difference optical spectral distribution with a database having a plurality of spectra.

***Response to Arguments***

7. Applicant's arguments, see page 7 final paragraph, filed 2/13/06, with respect to the rejection(s) of claim(s) 29 and 38 under 101 Statutory Double patenting, in particular the argument that subepidermal tissue is a different scope than tissue, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a nonstatutory double patenting rejection has been made.
8. The newly amended independent claims now overcome the prior art, Wunderman, used to reject the claims in the last office action. In particular the requirement for a difference database is not taught in Wunderman, nor would there be any motivation to combine Wunderman to include such a database.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Lavin whose telephone number is 571-272-7392. The examiner can normally be reached on M - F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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